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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/802,060      | 03/16/2004  | Richard G. Middleton | 105124-4000         | 3772             |

28765 7590 07/28/2006

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WASHINGTON, DC 20006

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| EXAMINER |
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OGDEN JR, NECHOLUS

|          |              |
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| ART UNIT | PAPER NUMBER |
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1751

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/802,060

Applicant(s)

MIDDLETON, RICHARD G.

Examiner

Necholus Ogden

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-19-2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

Claim 24 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn.

### ***Claim Objections***

Claims 1-4,13, 16 and 18 are objected to because of informalities is withdrawn.

### ***Claim Rejections - 35 USC § 102 or 103***

1. Claims 1 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Motsenbocker (6,929,702).
2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP (11-246898).

Claims 1-16, 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middleton (6,230,353) in view of EP (1300501) or "Carnovale".

### ***Double Patenting***

Claims 1-16, 18-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 1-16, 1-14, and 1-20 of U.S. Patent No. 6,009,585 or 6,536,061 or 5,538,646 or 5,916,336, respectively in view of EP 1300501.

### ***Response to Arguments***

Applicant's arguments filed 04-19-2006 have been fully considered but they are not persuasive.

Applicant argues that in a preferred embodiment the use of commercially available n-PB of Carnovale is not incorporated as a cleaning fluid. Rather, the n-PB that is used consists essentially of n-PB. Moreover, applicant argues that there would not have been any motivation to include the commercially available n-PB of Carnovale because it contains harmful stabilizers.

The examiner contends that applicant's claim reads on one compound n-propyl bromide and the "consisting essentially of" is construed as "comprising" because applicant has not provided a clear indication that the compound found in Carnovale is excluded. Specifically, the compound found in Carnovale is Comeco 2 and applicant states that he has "unable to confirm" (see footnote #2 in applicant's arguments) that the Comeco compound is or does comprise hazardous stabilizers. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. The examiner further contends

Art Unit: 1751

that the claims are directed toward a broad class of n-PB and they do not distinguish between any specific n-PB. Furthermore, applicant's specification invites the use of stabilizers as dictated by the dry-cleaning method and apparatus (0032) and states that n-PB is not considered by state and federal regulators to be a hazardous substance (0035). Accordingly, applicant's invention requires that the cleaning fluid is "environmentally sound" and therefore applicant has the burden of proven what is excluded from "environmentally sound". Nothing in the specification excludes any specific compounds or stabilizers as argued by applicant.

Applicant argues that the MSDS and EPA provide reasons not to use commercially available n-PB in dry cleaning process because of hazards and expected dangers.

The examiner contends that the reasons to check the MSDS or EPA are not determining factors of nonobviousness. Carnovale clearly suggest n-PB as a solvent in dry cleaning methods and provides motivation to replace perchloroethylene in the method and apparatus of Middleton. Moreover, it appears that the "concerns" of n-PB may have been outweighed by the toxicity and ground water pollution of perchloroethylene as suggested by Carnovale (0003). Again, "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant". In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Art Unit: 1751

Applicant argues that claim 21 "consists of" n-PB and Carnovale requires stabilizers.

The examiner contends that Carnovale specifically teaches that n-PB is the only cleaning solvent used in the dry cleaning method and the use of commercially available n-PB "Comexol" is suggested as a preferred solvent. Applicant has argued, but is "unable to confirm", that "Comexol" includes stabilizers, which should be excluded. The examiner contends that the teachings as a whole suggested by Carnovale include n-PB as the only cleaning solution used, which by the claimed definition is the only limitation that is closed. Furthermore, the inclusion of stabilizers is given little weight because of unsubstantiated evidence afforded by applicant. Moreover, for arguments sake, the inclusion of stabilizers for n-PB solvents is permissible in "consisting of" claim language because they would be construed as impurities. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

Applicant argues that there was not suggestion or motivation to combine the teachings of Middleton '353 and Carnovale because one of ordinary skill would not expect the method or apparatus to work or function (i.e. damage the cooling coil or galvanized piping).

The examiner contends that it is not a requirement that the motivation to combine result in a functioning method but that motivation exist to solve a problem such as replacing perchloroethylene with n-PB because the toxicity is lower than

Art Unit: 1751

perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021). Moreover, "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem". It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant". In *re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Applicant argues that there would have been no suggestion or motivation to combine the teachings of the '353 patent and Carnovale because of commercially available n-PB were used in the dry-cleaning process of '353 patent, hazardous substances would tend to collect and build up in the distillation equipment of the process.

Applicant argues that there would have been no motivation to combine the teachings of Middleton '353 and Carnovale to achieve the method of claim 25.

The examiner contends and respectfully disagrees because Middleton '353 specifically teaches the use of a closed loop system comprising at least one pneumatic stainless steel device (col. 4, lines 40-49) and Carnovale teaches replacing perchloroethylene with n-PB. Therefore, the skilled artisan would have been motivated to combine the reference to produce a dry cleaning method that has a toxicity that is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021). Again, the examiner contends that reason to modify a reference may be for a different purpose or to solve a different problem that may "The reason or motivation to modify the reference may often

Art Unit: 1751

suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant". In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Applicant argues the operability of Carnovale does not have a working device such that one of ordinary skill would have looked to Carnovale or commercially available n-PB as a perchloroethylene replacement.

The examiner contends that the operability of Carnovale is not a test for obviousness for the method claims of the present application. As suggested by Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done", reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention combine the references is suggested and The court held "it is not necessary in order to establish a prima facie case of obviousness . . . that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by applicant," and concluded that here a prima facie case was established because "[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties." 919 F.2d at 693, 16 USPQ2d at 1901. Therefore, as the motivating force is suggested by Carnovale such as replacing



Art Unit: 1751

perchloroethylene with n-PB because the toxicity is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021), one skilled would have combine the references for their intended purpose.

Applicant argues that Motsenbocher or Ozawa do not teach or suggest each and every element of the claim. Moreover applicant argues that said references teach other elements wherein they do not “consists essentially of” n-PB.

The examiner contends that applicant's claim reads on one compound n-propyl bromide and the “consisting essentially of” is construed as “comprising” because applicant has not provided a clear indication that the compounds found in Motsenbocher or Ozawa are excluded. Applicant's invention requires that the cleaning fluid is “environmentally sound” and therefore applicant has the burden of proving what is excluded from “environmentally sound”. Nothing in the specification excludes any specific compounds or stabilizers as argued by applicant. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. The examiner further contends that the claims are directed toward a broad class of n-PB and they do not distinguish between any specific n-PB.

Art Unit: 1751

2. With respect to the double patenting rejections. Applicant argues that the claims do not overlap in subject matter pertaining to removing or dry cleaning substances from textiles and separating the fluid from said textiles.

The examiner contends that the patents suggest method of cleaning or removing substances from textile absorbers and although they fail to suggest applicant's specific solvent n-MP, EP '501 teaches n-MP as a solvent to replace perchloroethylene in dry cleaning methods. Furthermore, It would have been obvious to one of ordinary skill in the art to substitute the perchloroethylene of 6,009,585 or 6,536,061 or 5,538,646 or 5,916,336 for the n-MP of EP '501 because EP '501 teaches that replacing perchloroethylene with n-PB because the toxicity is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021). With respect to applicant arguments that the patents include additional or optional steps that are not recited in the claims such as centrifuging and/or soaking. The examiner contends that the claims are limited by the transitional phrase of "consisting essentially of" however, said phrase is construed as comprising because applicant has not shown any deleterious effects by the additional steps claimed in the aforementioned patents.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholas Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-T, Th-Fri.

Art Unit: 1751

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nicholas Ogden  
Primary Examiner  
Art Unit 1751

No  
7-22-06